



RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE

IN THE U.S. PATENT AND TRADEMARK OFFICE

October 16, 2009

Applicants: Yoshio OKAMOTO et al

For: SEPARATING AGENT FOR ENANTIOMERIC ISOMERS

Serial No.: 10/551 681 Group: 1793

Confirmation No.: 5563

Filed: September 29, 2005 Examiner: Johnson

International Application No.: PCT/JP2004/005757

International Filing Date: April 22, 2004

Atty. Docket No.: 3400.P1423US

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

I am the attorney of record.

(Please see the following pages.)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on October 16, 2009.


Terrance F. Chapman

ARGUMENTS ACCOMPANYING REQUEST FOR REVIEW

Rejection of Claims 1-8 Under 35 USC 102(b) as
Anticipated By or, in the Alternative, Under 35 USC 103(a)
as Obvious over JP 2002-350413 to Okamoto et al

The presently claimed invention is directed to a separating agent for enantiomeric isomers which comprises a polysaccharide derivative carried on a porous carrier. The porous carrier has an epoxy group and the epoxy group and part of the hydroxyl groups of the polysaccharide derivative are chemically bonded.

Okamoto et al is directed to a separation column having a stable frit and a separation method of an optical isomer using the column. The frit is obtained by a dehydrating condensation reaction of an alkoxy silane. Although this reference discloses that a polysaccharide derivative can be fixed on a carrier by methods such as physical absorption between a polysaccharide derivative and a carrier, a chemical bond between carriers, a chemical bond of polysaccharide derivatives, a chemical bond of a third component, an optical exposure to a polysaccharide derivative and a radical reaction, there is no disclosure in this reference of the carrier silica gel having an epoxy group thereon, let alone a carrier having an epoxy group which is chemically bonded to part of the hydroxyl groups of the polysaccharide derivative.

Paragraph [0044] of Okamoto et al only discloses racemates or enantiomeric isomers that are optically separated with the separating agent disclosed there. There is no disclosure in this reference of a porous carrier having an epoxy group. As such, this reference not only does not anticipate the presently claimed invention under 35 USC 102(b), the presently claimed invention is so structurally different from the disclosure of Okamoto et al that Okamoto et al does not even present a showing of *prima facie* obviousness under 35 USC 103(a) with respect to the presently claimed invention.

Rejections of Claims 1-8 Under 35 USC 102(b) as
Anticipated By or, in the Alternative, Under 35 USC 103(a)
as Obvious Over JP 11-255671 to Onishi

The Onishi reference is directed to a polysaccharide derivative chiral stationary phase which is used to separate isomers by chromatography. Paragraph [0013] of this reference discloses that the polysaccharide derivative can be formed through the reaction of a polysaccharide at a hydroxyl group with an epoxy group. The porous carrier used in this reference is discussed in paragraph [0016] and there is no disclosure in this reference regarding a porous carrier having an epoxy group.

The presently claimed invention requires that a separating agent comprise a polysaccharide derivative carried on a porous carrier and that the porous carrier have an epoxy group and the epoxy group of the porous carrier and part of the hydroxyl groups of the polysaccharide derivative are chemically bonded. The references cited by the Examiner have no such disclosure. As such, it is respectfully submitted that the presently claimed invention is clearly patentably distinguishable over the prior art cited by the Examiner. Favorable consideration is respectfully solicited.

Respectfully submitted,



Terryence F. Chapman

TFC/smd

FLYNN, THIEL, BOUTELL
& TANIS, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1631
Phone: (269) 381-1156
Fax: (269) 381-5465

David G. Boutell	Reg. No. 25 072
Terryence F. Chapman	Reg. No. 32 549
Mark L. Maki	Reg. No. 36 589
Liane L. Churney	Reg. No. 40 694
Brian R. Tumm	Reg. No. 36 328
Heon Jekal	Reg. No. 64 219
Eugene J. Rath III	Reg. No. 42 094
Dale H. Thiel	Reg. No. 24 323
Sidney B. Williams, Jr.	Reg. No. 24 949

Encl: Notice of Appeal
Postal Card